

REMARKS

An excess claim fee payment letter is submitted herewith for 6 additional independent claims.

Claims 1 and 4-20 are all the claims presently pending in the application. Claims 1, 6, 11, 14, and 16-20 are amended to more clearly define the invention and claims 2-3 are canceled. Claims 1, 6, 11, 14, and 16-20 are independent.

Applicants thank Examiner Prunner for the courtesies extended to the Applicants' representative during a telephone interview on October 10, 2003. During the telephone interview, the Examiner alleged that there was no support for the spherical part being formed on the slider and the concave portion being formed on the holder. However, contrary to the Examiner's allegation, there is clear support for this feature in the specification at, for example, page, 4, line 19 through page 5, line 4.

Applicants gratefully acknowledge the indication by Examiner Prunner that the independent claims would be allowable if amended to recite that the said supported section of each holder includes a spherical part that is axially aligned with the remaining section of each holder. However, Applicants respectfully submit that all of the claims are allowable without reciting this language.

Applicants gratefully acknowledge that claims 11-16 and 17-19 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, as well as to overcome the rejections under 35 U.S.C. § 112, second paragraph. This Amendment rewrites claims 11, 14, and 16 - 19 to place them into independent form. Therefore, claims 11-19 are in condition for allowance. However, Applicants respectfully submit that all of the claims are allowable.

These amendments are made only to more particularly point out the invention for the Examiner and not for narrowing the scope of the claims or for any reason related to a statutory requirement for patentability.

Applicants also note that, notwithstanding any claim amendments herein or later during prosecution, Applicants' intent is to encompass equivalents of all claim elements.

Entry of this §1.116 Amendment is proper. Since the Amendments above narrow the issues for appeal and since such features and their distinctions over the prior art of record were discussed earlier, such amendments do not raise a new issue requiring a further search and/or consideration by the Examiner. As such, entry of this Amendment is believed proper and Applicants earnestly solicit entry. No new matter has been added.

Claims 1-5 and 11-16 stand rejected under 35 U.S.C. § 112, second paragraph and claims 1-10 and 20 stand rejected as being anticipated by the Schleif reference (U.S. Patent No. 4,948,285).

These rejections are respectfully traversed in the following discussion

I. THE CLAIMED INVENTION

In a first exemplary embodiment as defined by independent claim 1, the claimed invention is directed to a composite holding device that includes a casing for accommodating a plurality of holders for holding media to serve either different or similar purposes, supporting parts, each of which supports the corresponding holder and movable in an axial direction in the casing together with the holder, a feed mechanism, provided in the casing, for selectively advancing one of the supporting parts, and a manipulating mechanism for operating the feed mechanism, being adapted to project a tip of one of the plurality of holders

out of a fore end opening at a tip of the casing and make usable a tip of one of the plurality of holders. Each supporting part is adapted to support a section of each holder such that the supported section is adapted to be rotatably supported in relation to the supporting part. A spherical bearing is formed between the supporting part and the supported section provided on each of the holders. The spherical bearing includes a spherical part formed on either one of the supporting part and the supported section provided on a holder and a concave part formed on the other one of the supporting part and supported section provided on the holder to receive the spherical part.

In a second exemplary embodiment as defined by independent claim 6, the claimed invention is directed to a composite holding device that includes a holder body for holding a medium to serve a prescribed purpose, and a cap for detachably covering the holder body. The cap includes a casing for accommodating a plurality of holders, a supporting section for supporting the holders to be movable in an axial direction in the casing, a feed mechanism, provided in the casing, for selectively advancing one of the plurality of holders, and a manipulating mechanism for operating the feed mechanism, being adapted to project a tip of one of the plurality of holders out of a fore end opening at a tip of the casing and make usable the tip of one of the plurality of holders. Each holder is for holding a medium to serve a purpose either different from or similar to that of the medium.

In a third exemplary embodiment as defined by independent claim 20, the claimed invention is directed to a holding device that includes a casing for accommodating a plurality of holders for holding media, a supporting section for supporting the holders to be movable, means for selectively advancing one of the plurality of holders, and means for operating the advancing means, being adapted to project a tip of one of the plurality of holders out of a fore

end opening at a tip of the casing and make usable the tip of one of the plurality of holders. The supporting section is adapted to support a section of each holder such that the supported section is adapted to be rotatably supported in relation to the supporting section.

Conventional devices (such as shown by the Schleif reference) require that the holder forcibly deviate toward the opening in the sleeve case as a result of contact with the inner surface of the sleeve case. Therefore, the holders may become caught by the inner face of the sleeve case and may, thereby, be prevented from projecting out of the opening in the end of the sleeve case.

Additionally, this requirement that the holder be flexible limits the freedom in the choice of material and the dimensions of the holder.

Further, these conventional devices only permit the selective use of one of two holders which limits the range of applicability of different types of media.

In stark contrast, the present invention provides, in independent claim 1, a spherical bearing formed between the supporting parts and the supported section provided on each of the holders. The spherical bearing includes a spherical part formed on either one of the supporting part and the supported section provided on a holder and a concave part formed on the other one of the supporting part and supported section provided on the holder to receive the spherical part.

In this manner, the holders are allowed to rotate freely within the spherical bearing. Thus, the holders do not have to be flexible in order to bend along an inner surface of the sleeve case and the choice of materials may be significantly increased.

Further, the dimensions of the holder may also be reduced since the holder does not have to bend or be flexible.

Additionally, the present invention provides, in independent claim 6, a cap that has a casing, a supporting section, a feed mechanism, and a manipulating mechanism. In this manner, the present invention not only may provide, for example, a holder at the conventional end of a writing instrument, but the present invention provides a cap which incorporates features which enable the cap to provide additional holders. In this manner, the present invention increases the number of holders which are provided within a single device and, thereby, increases the availability of different types of media.

II. THE 35 U.S.C. § 112, SECOND PARAGRAPH REJECTION

The Examiner alleges that claims 1-5 and 11-16 are indefinite. While Applicant submits that such would be clear to one of ordinary skill in the art taking the present Application as a whole, to speed prosecution claim 1 has been amended in accordance with Examiner Prunner's very helpful suggestions.

In view of the foregoing, the Examiner is respectfully requested to withdraw this rejection.

II. THE PRIOR ART REJECTION

The Examiner alleges that the Schleif reference teaches the claimed invention. Applicant submits, however, that there are elements of the claimed invention which are neither taught nor suggested by the Schleif reference.

Independent claim 1 recites that a spherical bearing is formed between the supporting part and the supported section provided on each of the holders and the spherical bearing includes a spherical part formed on either end of the supporting part and the supported section

provided on a holder and a concave part formed on the other one of the supporting part and the supported section provided on the holder to receive the spherical part.

Similarly, independent claim 20 recites a supporting section that is adapted to support a section of each holder such that the supported section is adapted to be rotatably supported in relation to the supporting section.

As explained above, these features are important for allowing the holders to rotate freely within the spherical bearing. Thus, the holders do not have to be flexible in order to bend along an inner surface of the sleeve case and the choice of materials may be significantly increased.

Further, the dimensions of the holder may also be reduced since the holder does not have to bend or be flexible

The Examiner states that the Schleif reference discloses the spherical bearing constituted by the spherical top of sliders 13 (Fig. 8) and further the spherical part is formed on a supported section and a concave part is formed by the curved cam surface 19. As shown in Fig. 8, which is a top view of a slider, there is a cylindrical attachment 16 on the top. If the Examiner deems the cylindrical attachment 16 as the spherical part, the cylindrical attachment 16 is not spherical.

Furthermore, the concave part formed by the curved cam surface 19 does not receive the cylindrical attachment 16.

If the Examiner deems the nose 14 of the sliders 13 as the spherical part in Fig. 8, the nose 14 is not spherical and is not on the top of the sliders 13.

Furthermore, the concave part formed by the cam surface 19 does not advance in an axial direction together with the holder.

Indeed, the ball point pen disclosed by the Schleif reference suffers from the problems which are solved by the present invention. As shown by Fig. 9, the small tube 17 (holder), which is connected to one of the front cartridges 22 or 23, is firmly affixed to the cylindrical attachment 16 of the slide 13. Therefore, the small tube 17 cannot rotate relative to the slider 13 and, as a result, the front cartridge, which is axially aligned between the cylindrical attachment 16 and the circular bore 12, is forced to contact the inner surface of the bottom part 1 before the front cartridge can exit from the opening in the bottom part 1.

In other words, the small tube 17 and the front cartridge 22 or 23 is aligned with the cylindrical attachment 16 and the circular bore 12 which is radially offset from the opening in the bottom part 1. Thus, in order for the front cartridge 22 or 23 to exit the opening in the bottom part 1, the front cartridge 22 or 23 must contact the inner surface of the bottom part 1 and be forcibly bent in order to exit the opening.

In stark contrast, the present invention provides a spherical bearing which enables the holder to freely rotate. Therefore, the holders of the present invention are not required to flexibly bend and do not have to contact the inner surface of the sleeve.

Independent claim 6 recites that the cap comprises the casing, the supporting section, the feed mechanism, and the manipulating mechanism. However, in stark contrast, the displaceable cap 3 disclosed by the Schleif reference does not comprise a supporting section, a feed mechanism and a manipulating mechanism. Indeed, the cap 3 disclosed by the Schleif reference merely discloses a "space for accommodating accessories, for example, a stamping mechanism" (col. 2, line 62 - col. 3, line 9).

Lastly, regarding the means plus function recitations of independent claim 20, the Examiner has failed to interpret the claims to read only on the structures or materials

disclosed in the specification and “equivalents thereof.” The Federal Circuit has made it clear that the Office is required to interpret means plus function language in accordance with 35 U.S.C. § 112, sixth paragraph (see M.P.E.P. §2106; *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) and *In re Alappat*, 33 F.3d 1526, 1540 (Fed. Cir. 1994)). Clearly, the Examiner has failed to the claims to read only on the structures or materials disclosed by the present specification and “equivalents thereof.”

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1-10, and 20.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that claims 1 and 4-20, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

10/026,467
DOCKET NO. No.49

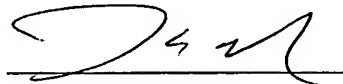
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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: _____

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